

*R&S* adding identification information to a non-standard signal included in a facsimile protocol transmission while the facsimile communication is performed with the facsimile *CDN* sender, the identification information indicating that the communication apparatus is capable of the electronic mail communication, detection of the identification information disconnecting the facsimile communication.

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REMARKS

Upon entry of the present amendment, claims 53, 56, 59, 60, 61, 63 and 66 will have been amended, while claims 7-11, 16, 20, 55 and 62 will have been canceled.

In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections asserted against the claims pending herein, in view of the herein contained amendments and remarks.

Initially, Applicants wish to make of record a telephone interview conducted between Applicants undersigned representative and Examiner Pokrzywa in the present application on April 10, 2003. During the above-noted interview, Applicants pointed out the shortcomings and deficiencies of the SUZUKI reference relied upon by the Examiner, as will be set forth hereinbelow. During the above-noted interview, Applicants representative further explained the operation of the presently disclosed apparatus, the manner in which the structure of the apparatus is recited in the claims and the features of the claims that are not disclosed nor suggested by the SUZUKI reference relied upon by the Examiner.

A more complete record of the above-noted interview will be set forth below. Moreover, Applicants wish to respectfully thank Examiner Pokrzywa for his knowledge and

courtesy in conducting the above-noted interview as well as for his helpful and constructive perspective on the prosecution of the present application.

In the outstanding Official Action, the Examiner indicated that by virtue of the prior amendment, all the claims including the previously non-elected claims are now being examined, as they are all drawn to the same invention. The Examiner's indication is noted with appreciation.

The Examiner further objected to claims 53, 59, 60 and 62 for various noted informalities. The Examiner's attention to these matters is noted with appreciation and in response, Applicants have eliminated each of the noted informalities.

The Examiner rejected claims 7-11, 16, 20, 53-57, 59-64 and 66 under 35 U.S.C. § 102(e) as being anticipated by SUZUKI (U.S. Patent No. 6,005,677). Applicants respectfully traverse the above rejection and submit that it is not appropriate with respect to the claims pending in the present application.

The present invention relates to, for example, an internet facsimile apparatus which includes a capability for transmitting data over the internet, as well as transmitting data via facsimile transmission. Thus, when a receiving apparatus has the capability to receive data over the internet, it is transmitted over the internet while when the receiving apparatus does not have the capability to receive data over the internet, the telephone network is utilized. Thus, the apparatus of the present invention determines whether or not the receiving apparatus can receive electronic data over the internet or whether the data must be transmitted to the receiving apparatus via facsimile transmission.

In particular, and as recited in claim 53, the communication apparatus includes a detector that detects identification information included in a non-standard signal which is transmitted from the destination while a facsimile protocol transmission is being performed. The identification information indicates whether or not the facsimile destination is capable of receiving electronic mail communications. Further, once it is determined that the identification information has been detected, a facsimile communication controller is provided that disconnects the facsimile communication. Thus, communication is performed through the computer network utilizing the electronic mail communicator. It is respectfully submitted that the features of claim 53 and the corresponding combinations of features recited in the various other independent claims are not taught, disclosed nor rendered obvious by the SUZUKI reference relied upon by the Examiner.

In setting forth the rejection of claim 55, the Examiner addressed the limitation of the facsimile communication controller that disconnects the facsimile communication when the detector detects the identification information in the non-standard signal. The Examiner made reference to column 5, lines 4-28 as seen in Fig. 4 and particularly, step 120. Applicants respectfully traverse the above rejection and submit that the Examiner's interpretation of the SUZUKI reference in this regard is incorrect. In particular, Applicants respectfully submit that step 120 refers to the restoring of a telephone line but does not refer to disconnecting a facsimile communication.

Initially, Applicants note that the restoring of the telephone line disclosed in step 120 of Fig. 4 occurs after the information has been transmitted, not "when said detector detects

the identification information in the non-standard signal", as recited in claim 53. In other words, step 120 obviously occurs after step 119 which is the actual image information transmission process. Moreover, and even more importantly, step 120 occurs when the answer to the query "registered number" in step 105 is NO. In other words, the entire chain of steps 112 through 120 occurs with respect to the transmission of data via facsimile rather than via the computer network, which occurs in steps 106 through 110. Thus, for example, claim 53 indicates that the facsimile communication is disconnected when the detector detects the identification information in the non-standard signal and that the identification information indicates that a facsimile destination is capable of electronic mail communication. In direct contrast, the flow chart in Fig. 4 of SUZUKI makes quite clear that the step 120 occurs when communication via a computer network is not even possible. In other words, the restoring of the telephone line in step 120 occurs after data is transmitted via the telephone network.

Thus, SUZUKI suffers from several deficiencies with respect to the recitations of claim 52. First of all, there is no disconnection, there is merely a restoring. SUZUKI is unclear as to in what manner the line is being restored. Regardless of the above however, the restoration of the line occurs after all the image data has been transmitted. Furthermore, the restoring of the telephone line occurs not in the situation where electronic mail communication is possible but in a situation where only facsimile communication is possible.

Moreover, the Examiner's reliance upon column 5, lines 4-13 is also misplaced. Therein, SUZUKI discloses that at step 114 a determination is made during receipt of the

non-standard function identifying signal whether the address information is included therein. If it is included (i.e., answer YES), in step 115 the conversion table, that was previously searched in step 104 (and which yielded a negative result) is renewed with the new address information. On the other hand, when the result of the query in step 114 is NO, the transmission is performed via facsimile in steps 116 through 119. Thus, this paragraph of the SUZUKI disclosure does not relate to the detector as recited in claim 53. In other words, even when in step 114 "identification information" in the form of the address is detected, that information is used, not to determine the type of data transmission to be utilized (i.e., disconnecting facsimile transmission) but to update a conversion table.

The above-noted shortcomings of the SUZUKI document were amongst those pointed out to the Examiner during the above-noted telephone interview.

In view of each of the above-noted shortcomings of the SUZUKI disclosure and certainly in view of all of the above-noted shortcomings of the SUZUKI disclosure, Applicants respectfully submit that the Examiner's rejection of any of the claims in the present application is inappropriate and respectfully request an indication regarding the allowability of all of the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

Applicants further note that the status of the present application is after final rejection and that Applicants are not permitted to amend an application once prosecution has been closed therein. Nevertheless, and in accordance with the provisions of 37 C.F.R. § 1.116, Applicants respectfully submit that entry of the present amendment is proper.

In particular, by the present Response, Applicants have incorporated the features of claim 55 into claim 53. Applicants have further submitted subject matter similar to claim 55 into the various other independent claims, of course modifying the language thereof to be consistent with the language of the respective independent claims. Applicants have also amended various of the claims to eliminate informalities noted by the Examiner and these amendments should also not give rise to new issues requiring further consideration or search. Claim 61 has been amended by the incorporation therein of the features of claim 62 and thus this amendment should not give rise to any new issues inquiring further consideration or search.

Accordingly, Applicants respectfully request entry of the present amendment, reconsideration of the outstanding rejection and an indication of the allowability of all of the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have canceled several claims and amended the various remaining independent claims to more clearly define the features of the present invention. Applicants have further removed the basis for objection to any of the claims based on the informalities noted by the Examiner.

Applicants have made of record a telephone interview conducted with the Examiner. Further, Applicants have reviewed the features of Applicants invention and have pointed out

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the shortcomings of the references cited thereagainst with respect thereto. Applicants have further discussed the disclosure of the reference and have shown how the features thereof do not meet the terms of the explicitly recited claim limitations. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all of the claims in the present application and respectfully request an indication to such effect, in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Yasuo NISHIDA et al.

Bruce H. Bernstein  
Reg. No. 29,027

May 14, 2003  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

**MARKED-UP COPY OF THE CLAIMS**

53. (Amended) A communication apparatus comprising:

a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network;

an [electric] electronic mail communicator that performs [electric] electronic mail communication with a destination terminal via a computer network; [and]

a detector that detects identification information included in a non-standard signal which is transmitted from a facsimile destination while said facsimile communicator performs a facsimile protocol transmission to the facsimile destination, the identification information indicating that a facsimile destination is capable of an electronic mail communication[.]; and

[The communication apparatus according to claim 53, further comprising] a facsimile communication controller that disconnects the facsimile communication when said detector detects the identification information in the non-standard signal.

54. (Amended) The communication apparatus according to claim 53, further comprising a memory that is configured to store the identification information[,] associated with the facsimile destination.

56. (Amended) The communication apparatus according to claim [55] 53, wherein said electronic mail communicator starts to perform the electronic mail communication with the facsimile destination upon disconnection of the facsimile communication.

59. (Amended) A communication apparatus comprising:

a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network;

an [electric] electronic mail communicator that performs [electric] electronic mail communication with a destination terminal via a computer network; [and]

an obtainer that obtains an electronic mail address of a facsimile destination, included in a non-standard signal which is transmitted from the facsimile destination while said facsimile communicator performs a facsimile protocol transmission to the facsimile destination, when the facsimile destination with which said facsimile communication section performs the facsimile communication, is capable of the electronic mail communication[.];  
and

a facsimile communication controller that disconnects the facsimile communication when the obtainer obtains the electronic mail address of the facsimile destination.

60. (Amended) A communication apparatus comprising:

a facsimile communicator that performs a facsimile communication with a facsimile sender via a telephone network;

an [electric] electronic mail communicator that performs [electric] electronic mail communication with a communication terminal via a computer network; and

an adder that adds identification information to a non-standard signal which said facsimile communicator transmits to the facsimile sender during a facsimile protocol communication, the identification information indicating that the communication apparatus

is capable of electronic mail communication[.], detection of the identification information disconnecting a facsimile communication.

61. (Amended) A method for identifying a destination terminal, the method comprising:

performing a facsimile communication with a destination terminal via a telephone network;

detecting whether identification information is included in a non-standard signal which is transmitted from the destination terminal while a facsimile protocol transmission is performed with the destination terminal, the identification information indicating that the destination terminal is capable of an electronic mail communication; [and]

storing the identification information when the identification information is detected[.]; and

disconnecting the facsimile communication when the detecting detects the identification information in the non-standard signal.

63. (Amended) The method according to claim [62] 61, further comprising initiating an electronic mail communication with the facsimile destination after the facsimile communication is disconnected.

66. (Amended) A method for transmitting an [electric] electronic mail communication function capability from a receiving terminal to a facsimile sender, the receiving terminal having an [electric] electronic mail communication section that performs

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[electric] electronic mail communication with a communication terminal via a computer network, the method comprising:

    performing a facsimile communication with the facsimile sender via a telephone network; and

    adding identification information to a non-standard signal included in a facsimile protocol transmission while the facsimile communication is performed with the facsimile sender, the identification information indicating that the communication apparatus is capable of the electronic mail communication[.], detection of the identification information disconnecting the facsimile communication.